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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,952	03/27/2001	Toru Teshima		5247

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EXAMINER

PHU, SANH D

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,952

Applicant(s)

TESHIMA, TORU

Examiner

Sanh D. Phu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-12 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 9/22/05.

Claims 2-6, 8-25 and 27-31 are currently pending in this application. Claims 13-25 and 27-30 are non-elected claims; they are therefore withdrawn from consideration. Claims 1, 7 and 26 are canceled.

Claim Rejections – 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed

before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 3, 6, 8, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Calvert (6,526,275), previously-cited.

–Regarding to claim 3, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a system (see figure 1) comprising:

advertisement delivery apparatus (104, 107, 109) including advertisement information storage means (109) for storing advertisement information to be delivered to a mobile communication instrument (101) at a location designated by a sponsor (213) of the advertisement information (see col. 5, line 5 to col. 10, line 50);

a mobile communication instrument (101) (see figure 2, and col. 6, line 5 to col. 8, line 5) for detecting current position and transmitting the detected current position to the advertisement delivery apparatus, for receiving said advertisement information and for outputting on a display screen (209) an advertisement based on the received advertisement information and input

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buttons, which is inherently included in “keypad” or “keyboard” and is invoked by a user (see col. 6, line 64 to col. 7, line 30); and

wherein said advertisement information delivery apparatus retrieves, from said advertisement information storage means, advertisement information relating to the designated location, responsive to the detected current position agreeing with or being proximate to the designated location, and delivers the retrieved advertisement information to said mobile communication instrument (see col. 5, line 5 to col. 10, line 50); and

wherein said advertisement information storage means stores location position information and said advertisement information storage means can retrieve, responsive to receipt of a signal from the input buttons indicating a request of the user, a path “direction” from a current position to an advertisement location (see (305) of figure 3, col. 6, line 66 to col. 7, line 30 and col. 9, lines 35–52) and wherein said mobile communication instrument displays said retrieved path on the display screen.

–Regarding claim 6, Calvert discloses that the advertisement information stored in said advertisement information storage means includes image data

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picturing an advertisement including at least one of trade name, business content, brand name and guide map (see col. 9, lines 46–52), and said mobile communication instrument includes a display screen (209) for displaying the pictured advertisement based on said image data (see figure 2, and col. 10, lines 33–50).

–Regarding claims 8 and 9, Calvert discloses that comprising delivery condition storage means included in (109) for storing at least one delivery condition for the advertisement information, whereby said advertisement information delivery means determines delivery to said mobile communication instrument according to said delivery condition wherein said delivery condition is at least one of presentation calendar period, presentation time of day, age group, and gender(s) (see col. 15, lines 45–67).

–Regarding claim 12, Calvert discloses that said mobile communication instrument is a mobile telephone (see col. 4, lines 34–36), and said mobile telephone is provided with current position detecting means (219, 221) for detecting its own current position (see figure 2).

Claim Rejections – 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert.

–Regarding claims 10 and 11, that said mobile communication instrument is a device (221, 215, 203), said device comprising a navigation (221), a transmitter (215) for transmitting current position information to said advertisement information delivery means, and a receiver (203) for receiving the advertisement information (see figure 2). Calvert does not disclose that said a device (221, 215) carried by a vehicle. However, since said device (221, 215) can be incorporated within a mobile, portable phone “cellular phone” (see col. 4, line 35), it would have been obvious for one skilled in the art that said

Calvert device (221, 215) being incorporated within a mobile, portable phone “cellular phone” could be carried on a vehicle, without affecting the overall system performance. Further regarding to claim 11, since being incorporated within a mobile, portable phone “cellular phone”, said device (221, 215) inherently transmits current position information to and receives advertisement information from advertisement information delivery means through said mobile, portable phone “cellular phone”.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert in view of Owensby (6,647,257), previously cited.

–Regarding claims 4 and 5, Calvert does not disclose that said advertisement information delivery apparatus further includes delivery data storage means for storing number of deliveries of advertisement information to mobile communication instruments or for storing number of times mobile communication instruments are to be a delivery target of advertisement information, each time advertisement information is delivered thereto.

Owensby teaches storing/recording information (Historical Response data) about history of deliveries of advertisement information to mobile

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communication instruments or the like for permitting messages, commercial information and advertisements to be targeted to as broad or narrow arrange of subscribers as desired by the sponsor of the message (see col. 5, lines 35–45).

Therefore, it would have been obvious for a person skilled in the art, when building or carrying out Calvert invention, within his skills and upon his design preference or system requirement, to implement storage means included in said advertisement information delivery apparatus (109) (see figure 1) for storing such as number of deliveries of advertisement information to mobile communication instruments or for storing number of times mobile communication instruments are to be a delivery target of advertisement information, each time advertisement information is delivered thereto, as history of deliveries of advertisement information, as taught by Owensby, so that said advertisement information delivery apparatus would permit messages, commercial information and advertisements to be targeted to as broad or narrow arrange of subscribers as desired by the sponsor (120) of the message.

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7. Claims 2 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert in view of New Riverside University Dictionary, newly-cited.

-Regarding claims 2 and 31, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a method (see figure 1) comprising:

step (109, 120) of designating, by a sponsor (120) of the advertisement information, a location at which the advertising information is to be delivered to a mobile communication instrument (101);

step (109) of storing in memory the advertisement information to be presented at the designated location;

step (101) of transmitting information for the current position of the mobile communication instrument from the mobile communication instrument to an advertisement information delivery apparatus (1404, 107, 109) remote from the mobile communication instrument and including the memory (109);
and

step of (104, 107, 109) retrieving advertisement information relating to the current position from the memory based on the current position

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information received from the mobile communication instrument, and delivering the retrieved advertisement information to the mobile communication instrument.

Calvert does not disclose step of calculating advertisement delivery charges for the delivery based on delivery prices relating to at least one of advertisement content delivered and an advertisement condition, and charging, or liquidating by payment, the calculated advertisement delivery charges to the sponsor.

However, in Calvert, the sponsor has to pay the context engine server (115) or a system operator of the context engine server for charges for the delivery based on delivery prices relating to at least one of advertisement content delivered and an advertisement condition (e.g., based on presentation calendar period (yearly) prices) (see figure 1, col. 3, lines 61–67, col. 9, lines 35–67).

A process of invoicing and billing a payee, in which all costs that the payee has to pay are accounted or calculated so that an itemized list of service rendered, with an account of all costs is made to bill the payee, is well-known

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in the art. For instance, New Riverside University Dictionary teaches such a process as being illustrated via a definition of term "invoice", listed on page 642, as an itemized list of services rendered, with an account of all costs for billing, or as an action to make an invoice for billing.

It would have been obvious for a person skilled in the art to implement Calvert context engine server (115) or the system operator of context engine server with a process invoicing and billing, as taught by New Riverside University Dictionary, in such a way that the context engine server (115) or the system operator of context engine server would carry out calculating advertisement delivery charges for the delivery based on delivery prices relating to at least one of advertisement content delivered and an advertisement condition (e.g., based on presentation calendar period (yearly prices) so that an itemized list of said advertisement delivery services rendered, with an account of all costs is made, and would carry out calculating charging the calculated advertisement delivery charges by billing the invoice to the sponsor, so that the sponsor would know how much the charges he has to pay.

Response to Arguments

8. Applicant's arguments filed on 9/22/05 have been fully considered but they are not persuasive.

-Regarding claim 3, the applicant argues that the "direction" from a current position to an advertisement location, being described in Calvert is not equivalent with the term "path" recited in the claim. The examiner respectfully disagrees. In order to clarify that term "direction" can be considered is equivalent with term "path", the examiner now cites New Riverside University Dictionary, page 381, defining term "direction" as "a line leading to a place or point". Based on this definition, the "direction" from a current position to an advertisement location, being described in Calvert can be interpreted as a line or path from a current position to an advertisement location.

-Further, regarding claims 2 and 3, the claims after being amended are deemed not patentable with reasons in the corresponding rejections set forth above in this Office Action.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D. Phu whose telephone number is (571)272-7857. The examiner can normally be reached on 8:00-16:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quochien Vuong can be reached on (571)272-7902.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanh D. Phu
Examiner
Art Unit 2682

SP

 11/21/05
QUOCHIE B. VUONG
PRIMARY EXAMINER